



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,522	04/04/2005	Tatsuya Matsui	122137	7794

25944 7590 10/18/2006

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/518,522

Applicant(s)

MATSUI ET AL.

Examiner

Nathan M. Nutter

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 1711

DETAILED ACTION

This application has been re-assigned to Examiner Nathan M. Nutter in Art Unit 1711. All inquiries regarding this application should be directed to Examiner Nutter at telephone number 571-272-1076.

Specification

The disclosure is objected to because of the following informalities:

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is the Examiner's position that the claims as written are indefinite and/or confusing. For example, claim 1 recites that component A) is a polycarboxylic acid

Art Unit: 1711

copolymer obtained by esterifying the acid groups of a polycarboxylic acid copolymer having a "polyoxyalkylene chain with a derivative of an alcohol having a polyoxyalkylene chain and represented by formula (1)". It is not clear whether the copolymer has a polyoxyalkylene chain with an alcohol derivative or it is the alcohol that has a polyoxyalkylene chain, and is represented by said formula.

Claim 2 is still deemed vague since the recitation, as amended, of "a" polyoxyethylene compound can be either that of "(a)" or "(b)" without being specific to which copolymer is intended.

Claim 6 recites an additive comprising components (A) and (B), but both A and appear to be the same compounds. See the formula for component (A) in claim 1. Similarly, further dependent claims also recite an additional component (C) which is also a polycarboxylic acid copolymer comprising polyoxyalkylene chains. It is not clear how this additional component is different from the other two components (A) and (B).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by

JP 06-298556.

Art Unit: 1711

The cited reference discloses the manufacture of compositions as an additive for cement comprising copolymers polycarboxylic acid and an alcohol having polyoxyalkylene chains as claimed. The prior art disclosures have features and characteristics as claimed. Physical characteristics not expressly disclosed would appear to be inherent in view of the various other characteristics disclosed.

Applicants argue that this prior art is different because it discloses additives with several combinations or possibilities of combination of the various components. The Examiner does not find Applicants' arguments convincing because the prior art does disclose the copolymer having the various units.

Response to Arguments

Applicant's arguments filed 31 August 2006 have been fully considered but they are not persuasive.

With regard to the rejection of claims 1-14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, the language of claim 1 is not clear and concise. The language does not recite what the "polycarboxylic acid series esterified copolymer" is as to its metes and bounds, only how it might be obtained. There are no recitations as to any copolymer structure since the language with regard to "(a)" or "(b)" does not define a single resin, nor is the recitation in the alternative "(a)" or "(b)." Claim 2 is not vague due to applicants' amendment, as pointed out in the rejection, above. As regards claim 6, it is pointed out that the language of claim 1 does

Art Unit: 1711

not teach that component (A) is "a reaction product of components (a) and (b)" as applicants contend.

With regard to the rejection of claims 1-14 under 35 U.S.C. 102(b) as being anticipated by JP 06-298556, it is pointed out once more that claim 1 does not teach that component (A) is "a reaction product of components (a) and (b)." Further, applicants must show why the Formula II does not anticipate the recitations herein, not merely opine as to what is disclosed that may not be recited in the instant claims. the burden is on applicants to show why the patent discloses are not anticipatory since the reference discloses what is recited and claimed herein. As long as the reference shows values embracing those recited using constituents, as recited, the reference is deemed relevant to the instantly claimed invention. A reference is taken for the entirety of its teachings and not for isolated passages or Examples intended to proffer patentability on the instant claims. the comparison made in the Declaration was not made with the actual breadth of the patent teachings a single, isolated example. Again, a reference is viewed for the entirety of its teachings. Since the reference teaches values for $n1=1-8$, a comparison of that realm would be necessary to negate the teachings therein. Further, when a reference discloses all of the limitations of a claim except a property or function, and the Examiner is unable to determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note *In re Fitzgerald et al* 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). Note MPEP § 2112-2112.02. For these

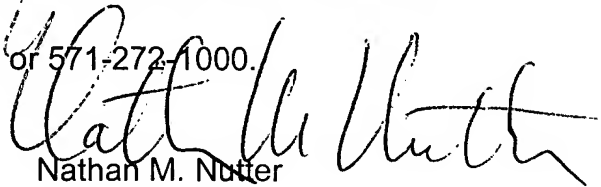
Art Unit: 1711

reasons, the Declaration of Matsui, of 31 August 2006, is hereby dismissed since the composition of the reference chosen for comparison

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

15 October 2006